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09/964,753	09/28/2001	Marc Chauchard	01682.0110	3109

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EXAMINER
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BASEHOAR, ADAM L

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/964,753

Applicant(s)

CHAUCHARD ET AL.

Examiner

Adam L. Basehoar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to communications: The Amendment filed 01/19/06 to the RCE filed 08/04/05.
2. Claim 18 has been added as necessitated by Amendment.
3. Claims 15-16 have been cancelled as necessitated by Amendment.
4. The rejection of claims 1 and 14 under 35 U.S.C. 112, second paragraph, has been withdrawn as necessitated by Amendment.
5. The rejection of claims 1-2, 6-14, and 15-17 under 35 U.S.C. 103(a) as being unpatentable over Berke (US: 6,629,092 09/30/03) in view of Coakley (US-2002/0194116 12/19/02) in further in view of Tran (US-2001/0049707 12/06/01) have been withdrawn as necessitated by Amendment.
6. Claims 1-14 and 17-18 are pending in the case. Claims 1 and 14 are independent claims.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-14 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US-7,016,851 03/21/06) in view of the USPTO's, "Trademark/Service Mark Application,

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Principal Register, with Declaration", 08/22/00, pp. 11. (The Printed archived Web Pages show the automated USPTO's Trademark Electronic Application System and will hereafter be referenced as "TEAS").

-In regard to independent claim 1, Lee teaches a process for registering a trademark by means of a local computer (Fig. 2: 221) connected to a remote computer (Fig. 2: 231, 234, 241, 253, etc) via a computer Internet network (column 7, lines 40-41 and 61-62) performing the following steps in order:

entering the trademark (column 1, line 17; column 12, lines 30-31: i.e. through the filing of formal and technical documents pertaining to a trademark) to be filed at the national administrative department (Fig. 2: 241, 253: "EPO", "JPO");

sending the validated entry and selection (Fig. 2: 208A, 208B) to the remote computer via the network, the remote computer (Fig. 2: 231, 234: "Associate A", "Associate B") being disposed on a premises of an intellectual property attorney for reviewing the trademark application (column 2, lines 3-5: "attorneys or agents.....given jurisdiction"; column 8, lines 53-67; column 9, lines 1-9); and

retransmitted the validated entry and selection (Fig. 2: 209A, 209B) from the premises of the IP attorney (Fig. 2: 231, 234: "Associate A", "Associate B") to another remote computer to enable the application to be prosecuted at the national administrative department (Fig. 2: 241, 253: "EPO", "JPO").

Lee does not specifically teach selecting the products or services to which the trademark applies from at least one of an official class and validating the entry and the selection. TEAS teaches selecting the products or services to which the trademark applies from at least one of an

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official class (Page 4: "International Class" and "Listing of Goods and/or Services") and validating the entry and the selection (Page 8: "Validate Form"). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to dependent claim 2, Lee teaches cooperation between the local computer and the remote computer (Fig. 2).

-In regard to dependent claim 3, Lee teaches the validated entry and selection being re-transmitted from the remote computer to another remote computer by electronic mail (column 10, lines 59-67; column 11, lines 1-6).

-In regard to dependent claim 4, Lee teaches scanning formal documents for the trademark application (Fig. 2: 232). Lee does not specifically teach wherein the scanner was used to scan a model of the trademark. It would have been obvious to one of ordinary skill in the art at the time of the invention for the user of the scanner of Lee, to have used it to scan the model of the trademark, because it was notoriously well known in the art at the time of the invention that for an application for a trademark to be complete a model/drawing/representation

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of the mark needed to be included in the application and that a scanner would be an alternative way to enter the model/drawing into the application.

-In regard to dependent claim 5, Lee teaches transmission to the remote computer of the scanned model of the trademark, via the computer network (Fig. 2).

-In regard to dependent claims 6 and 7, Lee does not specifically teach teaches choosing a heading of at least one official class of products or services and displaying a corresponding number of the class or choosing at least one number of an official class of products or services and displaying a corresponding heading of the class. TEAS teaches displaying both one number of an official class of products or services with its heading and vice versa (Page 4: "International Class" and "001-042, A,B, or 200"; Page 11: e.g. "028" and "Table Tennis balls"). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to dependent claim 8, Lee teaches entering at least one freely chosen wording (Page 4: "Listing of Goods and/or Services"). Lee does not teach comparing said freely chosen wording with the potential wordings contained in a file; displaying words proposed from among potential wordings; selecting at least one wording from among the wordings proposed; and

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displaying the number of the official class corresponding to the wordings selected. TEAS

teaches:

entering at least one freely chosen wording (Page 10: "Please enter any word....services");

comparing said freely chosen wording with the potential wordings contained in a file (Page 10: "searchable index");

displaying words proposed from among potential wordings (Page 11: e.g. "Table Tennis Balls");

selecting at least one wording from among the wordings proposed (Page 11: i.e. user selects identification code which best matches search query term);

displaying the number of the official class corresponding to the wordings selected (Page 11: "028").

It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to dependent claim 9, Lee does not teach file containing the wordings of the official classification of trademarks and the number of the class corresponding to each wording. TEAS teaches file (Page 10: "searchable index") containing the wordings of the official

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classification of trademarks and the number of the class corresponding to each wording (Page 11). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to dependent claim 10, Lee teaches wherein the file further includes additional wordings not featuring in the official classification of trademarks and the number of the class corresponding to each of these additional wordings (Page 11: e.g. "028", "Table tennis bats", "Table tennis tables"). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to dependent claim 11, Lee teaches using comparison software permitting a display of a proposed wording identical with the freely chosen wording (Page 11: "table tennis" and "Table tennis"). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that



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with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to dependent claim 12, Lee teaches wherein the comparison permits the display of a proposed wording including the freely chosen wording (Page 11: i.e. shows “Table tennis bats” and “Table tennis balls” with the freely chosen wording of “table tennis”). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to dependent claim 13, Lee teaches wherein the software permits the display of a proposed wording synonymous with the freely chosen wording (Page 11: e.g. “Table tennis paddles” and “Table tennis rackets”). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to independent claim 14, Lee teaches a process for preparing a trademark application to be filed at a national administrative department (Fig. 2: 241, 253: "EPO", "JPO"), (Fig. 2: 221) connected to a remote computer (Fig. 2: 231, 234, 241, 253, etc) via a computer Internet network (column 7, lines 40-41 and 61-62) performing the following steps in order:

entering the trademark (column 1, line 17; column 12, lines 30-31: i.e. through the filing of formal and technical documents pertaining to a trademark) to be filed at the national administrative department (Fig. 2: 241, 253: "EPO", "JPO");

entering at least one freely chosen wording for describing the products or services to which the trademark applies (Page 4: "Listing of Goods and/or Services");

sending the validated entry and selection (Fig. 2: 208A, 208B) to the remote computer via the network, the remote computer (Fig. 2: 231, 234: "Associate A", "Associate B") being disposed on a premises of an intellectual property attorney for reviewing the trademark application (column 2, lines 3-5: "attorneys or agents.....given jurisdiction"; column 8, lines 53-67; column 9, lines 1-9); and

retransmitted the validated entry and selection (Fig. 2: 209A, 209B) from the premises of the IP attorney (Fig. 2: 231, 234: "Associate A", "Associate B") to another remote computer to enable the application to be prosecuted at the national administrative department (Fig. 2: 241, 253: "EPO", "JPO").

Lee does not teach comparing said freely chosen wording with the potential wordings contained in a file of at least one official class of products and services; selecting at least one wording from among the wordings proposed; displaying the number of the official class corresponding to the wordings selected; and validating the entry and the selection. TEAS

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teaches entering at least one freely chosen wording (Page 10: "Please enter any word....services"); comparing said freely chosen wording with the potential wordings contained in a file (Page 10: "searchable index"); displaying words proposed from among potential wordings (Page 11: e.g. "Table Tennis Balls"); selecting at least one wording from among the wordings proposed (Page 11: i.e. user selects identification code which best matches search query term and thus their trademark); displaying the number of the official class corresponding to the wordings selected (Page 11: "028"); and validating the entry and the selection (Page 8: "Validate Form"). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2: 221) transmitting the trademark filing documents (column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23).

-In regard to dependent claims 17 and 18, Lee teaches transmission to the remote computer (Fig. 2: 231, 234: "Associate A", "Associate B") an identity of the trademark applicant to complete the registration file and the retransmitting step includes transmission of the identity of the trademark applicant from the premises of the IP attorney (column 2, lines 3-5: "attorneys or agents.....given jurisdiction"; column 8, lines 53-67; column 9, lines 1-9) to the another remote computer (Fig. 2: 241, 253: "EPO", "JPO").

***Response to Arguments***

9. Applicant's arguments with respect to claim 1 and 14 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

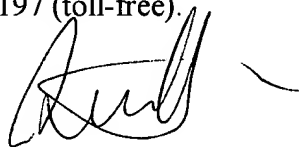
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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L. Basehoar whose telephone number is (571)-272-4121.

The examiner can normally be reached on M-F: 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ALB

**STEPHEN HONG**  
**SUPERVISORY PATENT EXAMINER**